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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,161	08/10/2006	Ulrich Peuchert	3811	6875
7590	01/15/2009		EXAMINER	
Striker Striker and Stenby 103 East Neck Road Huntington, NY 11743			JOHNSON, KEVIN M	
			ART UNIT	PAPER NUMBER
			1793	
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			01/15/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/589,161	<b>Applicant(s)</b> PEUCHERT ET AL.
	<b>Examiner</b> KEVIN M. JOHNSON	<b>Art Unit</b> 1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 08 October 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 38,40-47 and 49-83 is/are pending in the application.

4a) Of the above claim(s) 51-80 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 38, 40-47,49,50 and 81-83 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/06)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Status***

1. Claims 39 and 48 are cancelled. Claims 38, 42-45 and 49 are amended. New claims 81-83 are added.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 38, 40-47 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (US 6800574).

In regard to claims 38, 40-47 and 81, Anderson teaches a glass composition that consists of greater than 80 wt-% SiO<sub>2</sub>, 4-15 cation/anion-% of a modifying dopant and 0.0015-5 cation-% rare earth dopant (column 4, lines 8-35). The modifying dopant may be Zirconium (column 5, lines 48-58), and the rare earth dopant may be Ytterbium (claim 4). The dopants may be in oxide form (column 5, lines 59-60).

It is well established that when ranges disclosed in the prior art overlap with the ranges required in the instant claims a case of *prima facie* obviousness exists (MPEP 2144.05). Further, as the glass composition taught in Anderson is the same as the composition required by the claims it would necessarily follow that the composition taught by Anderson would be capable of acting as an X-ray opaque glass.

6. Claims 49, 50, 82 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson as applied to claim 81 above, and further in view of Kunert et al. (US 6297181).

In regard to claims 49 and 82, Anderson fails to teach a glass powder with a mean grain size of 0.2-20 microns.

Kunert teaches that a glass may be converted in a known manner, such as grinding and sieving, to a powder with a mean particle size of 0.5-5 microns (column 7, lines 9-13). This small particle size allows the glass powder to be incorporated in to

composites with improved abrasion resistance and mechanical strength (column 7, lines 13-16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to produce a glass powder with a mean grain size in the required range of from the glass composition taught by Anderson. Such a modification would have been motivated by the teaching in Kunert that a glass powder with the a mean particle size of 0.5-5 microns would increase the industrial applicability of the glass taught by Anderson by improving its usefulness in composite materials.

In regard to claims 50 and 83, Anderson fails to teach that the glass material has a silanized surface.

Kunert teaches that the surfaces of glass powder particles are commonly silanized to promote increased performance (column 7, lines 24-28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to produce a glass powder from the glass composition taught by Anderson with a silanized particle surface. Such a modification would have been motivated by the teaching in Kunert that silanation of glass powder particle surfaces is a common practice, increasing the performance of the material.

#### ***Response to Arguments***

7. Applicant's arguments with respect to claims 38, 40-47, 49, 50 and 81-83 have been considered but are moot in view of the new ground(s) of rejection.

The new grounds of rejection is necessitated by the amendment of the claims to utilize the closed "consisting of" language, effectively narrowing the scope of the claims.

8. Applicant's arguments with respect to the U.S.C. 112 second paragraph rejection of claims 38, 42-47 and 49 have been fully considered and are persuasive. The rejection of claims 38, 42-47 and 49 has been withdrawn.

The compositional ranges in claims as amended are no longer indefinite.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN M. JOHNSON whose telephone number is (571)270-3584. The examiner can normally be reached on Monday-Friday 7:30 AM to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.A. LORENZO/  
Supervisory Patent Examiner, Art Unit 1793

/Kevin M Johnson/  
Examiner, Art Unit 1793